

REMARKS

At the time of the First Office Action dated June 16, 2008, claims 1-20 were pending and rejected in this application.

CLAIMS 1-20 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON BY GALET AL., U.S. PATENT NO. 6,167,445 (HEREINAFTER GAI), IN VIEW OF ROGERS ET AL., U.S. PATENT NO. 5,557,747 (HEREINAFTER ROGERS)

On pages 2-8 of the Second Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Gai in view of Rogers to arrive at the claimed invention. This rejection is respectfully traversed.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness."¹ The legal conclusion of obviousness is based on underlying findings of fact including the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent arts.² "Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."³ Therefore, to properly make a finding of obviousness, a comparison between the applied prior art and the claims at issue must be made to ascertain the differences between what is being claimed and the teachings of the applied prior art. Moreover,

¹ *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

² *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007).

³ *Id.* (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

before making a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed.⁴

Claim 1

Independent claim 1, in part, recites "a workflow component configured for communicative linkage to a plurality of policy makers." To teach this limitation, the Examiner referred to feature 410 of Fig. 4 as corresponding to the policy maker. The Examiner's analysis is deficient in at least two respects. First, the Examiner does not identify the alleged "workflow component." Second, the claimed invention refers to a plurality of policy makers. However, the Examiner's cited figure only refers to a single policy translator 410. Thus, the Examiner has failed to establish that Gai teaches the limitations for which the Examiner is relying upon Gai to teach.

Regarding the claimed "said workflow component comprising a further configuration for routing stimuli and response data from said system under study to a selected one of said policy makers," the Examiner again failed to specifically identify the claimed workflow component. Moreover, the Examiner's analysis fails to establish that Gai teaches that "stimuli and response data" is routed to "a selected one of said policy makers."

Regarding the claimed "a policy generation component coupled to said workflow component and configured to generate an administrative policy for administering said system

⁴ See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994); see also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

under study based upon data collected from said selected one of said policy makers for said stimuli and response data," the Examiner cited column 6, lines 12-17 of Gai. However, Gai does not teach generating an administrative policy based upon collected data. Instead, Gai teaches using high-level policies, which are selected by a network administrator and translated by one or more policy servers into a set of rules (see column 5, line 66 through column 6, line 2). Thus, the Examiner has yet again failed to establish that Gai teaches the limitations for which the Examiner is relying upon Gai to teach.

Regarding the teachings of Rogers, Applicants are unclear as how column 2, lines 6-18 (i.e., the only passage cited by the Examiner) differs from the teachings already within Gai. Gai already teaches automating an interactive network administration process (see, e.g., column 6, line 58 through column 7, line 29). As such, the Examiner's cited passage within Rogers does not add anything new to the teachings already found within Gai, which the Examiner has already acknowledged does not identically disclose the claimed invention.

Regarding the Examiner's obviousness analysis, the Examiner stated in the paragraph spanning pages 3 and 4 the following:

Gai and Rogers are analogous art because they are from the same field of endeavor of computer networks and policy. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Roger's elements with Gai's system. The suggestion/motivation would be to provide a mechanism for automating the network administration process (Rogers, col. 2, lines 6-9).

Applicants respectfully submit that the Examiner's obviousness analysis is deficient in several respects.

As to the Examiner's assertion of "suggestion/motivation," the Examiner appears to be employing the "Teaching, Suggestion, or Motivation in the Prior Art" rationale described under KSR. However, the Examiner has failed to produce the requisite findings of fact described in the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007) as to rationale G (i.e., "Some Teaching, Suggestion, or Motivation in the Prior Art That Would Have Led One of Ordinary Skill To Modify the Prior Art Reference or To Combine Prior Art Reference Teachings To Arrive at the Claimed Invention." As described therein, the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness

This burden has not been met.

The Examiner's analysis is both silent as to precisely how one having ordinary skill in the art would modify Gai in view of Rogers. Moreover, the Examiner has failed to make any factual findings that there was a reasonable expectation of success in such a combination.

Applicants also note that the Examiner's alleged benefit for the rationale (i.e., for automating the network administration process) would not have motivated one having ordinary skill in the art to make the proposed modifications. Specifically, the Examiner's alleged problem to be solved is has already by accomplished by Gai. Since the problem has already been solved,

one having ordinary skill in the art would not have been realistically impelled to make the Examiner's proposed modification.⁵

Claim 3

To teach the claimed "detecting a stimuli in a system under study and monitoring a response by a systems administrator to said stimuli," the Examiner cited column 9, lines 51-55 and column 12, lines 1-5. The Examiner's cited passage of column 9, lines 51-55 is completely silent as to detecting a stimuli in a system under study and monitoring a response by a systems administrator to the stimuli, as claimed. Instead, this passage refers to implementing a high-level traffic management policy to dissimilar intermediate devices in a network. The Examiner's second cited passage of column 12, lines 1-5 also fails to identically disclose this limitation. Although this passage refers to traffic types (presumably allegedly corresponding to the claimed "stimuli"), this passage is silent as to monitoring a response to a systems administrator to the stimuli.

Although the above-reproduced arguments were previously presented on page 4 of the First Response dated March 5, 2008, the Examiner failed to respond to these arguments. In this regard, the Examiner is referred to M.P.E.P. § 707.07(f), entitled "Answer All Material Traversed," which clearly states that upon Applicants traversing the Examiner's rejection, "the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Moreover, M.P.E.P. § 707.07(f) also states that even if the arguments are moot in view of the new ground(s) of rejection, the "examiner must, however,

⁵ See the non-precedential opinion of *Ex parte Rinkevich*, Appeal 2007-1317 ("we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

address any arguments presented by the applicant which are still relevant to any references being applied" (emphasis added). Since these arguments are still relevant to Gai, the Examiner has failed to follow the specific directions of the M.P.E.P. in this matter.

To teach the claimed "forwarding said stimuli and said response to a policy maker suited to analyze said stimuli and said response," the Examiner cited column 9, lines 55-57. The Examiner's cited passage, however, refers to a policy and not a stimuli and response by a systems administrator to the stimuli, as claimed. Moreover, the Examiner's cited passage fails to disclose that the stimuli/response data is forwarded to a policy maker suited to analyze the data. Again, despite these arguments being previously presented in the First Response, the Examiner did not respond to them.

To teach the claimed "querying said policy maker for a preferred response to said stimuli," the Examiner cited column 7, lines 10-19. The Examiner's cited passage, however, refers to exchange of messages between an intermediate device and a policy server but is silent as to querying a policy maker for a preferred response to the stimuli. In this regard, the Examiner's cited passage is completely silent as to the stimuli. Despite these arguments being previously presented in the First Response, the Examiner did not respond to them.

To teach the claimed "formulating a policy for responding to said stimuli based upon said preferred response," the Examiner cited column 7, lines 21-24. Again, the Examiner's cited passage is completely silent as to the stimuli, upon which the policy is formulated. Despite these

arguments being previously presented in the First Response, the Examiner did not respond to them.

The Examiner's analysis regarding Rogers is inconsistent with the Examiner's previously-stated assertions. For example, the Examiner asserts that Gai teaches "monitoring a response by a systems administrator to said stimuli" on page 4 of the Second Office Action, but on page 5 of the Second Office Action, the Examiner is relying upon Rogers to teach this limitation. The Examiner makes the same ambiguous assertions as to other limitations on pages 4 and 5 of the Second Office Action.

Notwithstanding the Examiner's failure to properly characterize the scope and content of the applied prior art, Appellants incorporate herein, as applying to claim 3, the arguments previously presented as to claim 1 regarding the Examiner's citation to Rogers and the Examiner's obviousness analysis.

For above-described reasons, the Examiner has failed to establish that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Gai and Rogers within the meaning of 35 U.S.C. § 103. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-20 under 35 U.S.C. § 103 for obviousness based upon Gai in view of Rogers.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 21, 2008

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320